

RECEIVED  
CENTRAL FAX CENTER

FEB 15 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): ADLER, Sam et al. EXAMINER: Not Yet Assigned  
SERIAL NO.: 10/541,191 GROUP ART UNIT: Not Yet Assigned  
FILED: June 30, 2005 ATTORNEY DOCKET No.: P-5608-US  
FOR: METHOD FOR IN VIVO SENSING

Mail Stop, Missing Parts  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION AND  
PETITION FOR A FOUR-MONTH EXTENSION OF TIME**

Sir:

In response to the Notice to File Missing Parts of Application under 37 CFR 1.53(b), mailed August 17, 2006 (a copy of which is enclosed), and in conjunction with a Response to the Decision on Request Under 37 CFR 1.497(d) mailed August 17, 2006, being filed herewith, Applicants submit herewith the following:

☒ an executed Declaration and Power of Attorney making reference to the above-identified application, and in compliance with 37 C.F.R. 1.63;

No fees are believed to be due in connection with this paper, as the surcharge fee for the late filing of the Declaration has been paid previously, and the fees for the petition for extension of time are being paid with the Response to the Decision.

BEST AVAILABLE COPY

APPLICANTS: ADLER, Sam et al.  
 SERIAL NO.: 10/541,191  
 FILED: June 30, 2005  
 Page 2

RECEIVED  
 CENTRAL FAX CENTER

FEB 15 2007

| FEE CALCULATION  |                                     |   |                                       |                  |          |
|--|-------------------------------------|---|---------------------------------------|------------------|----------|
| <b>1. BASIC FILING FEE</b>                               |                                     |   |                                       |                  |          |
|  | Filing Date BEFORE December 8, 2004 |   | Filing Date ON/AFTER December 8, 2004 |                  |          |
|  | Large Entity Fee                    | Small Entity Fee                        | Large Entity Fee                      | Small Entity Fee |          |
| Utility  | \$790                               | \$395                                   | \$1000                                | \$500            | 0        |
| Provisional  | \$160                               | \$80                                    | \$200                                 | \$100            | 0        |
| Application Size Fee (over 100 pages, per 50)            |                                     |   | \$250                                 | \$125            | 0        |
| <b>2. EXTRA CLAIM FEES</b>                               |                                     |   |                                       |                  |          |
| Total Claims   |                                     | -20 =                                   |                                       | x \$50 =         |          |
| Independent Claims                                       |                                     | -3 =                                    |                                       | x \$200 =        |          |
| Multiple Dependent                                       |                                     |   |                                       | x \$360 =        |          |
|  | Large Entity Fee                    | Small Entity Fee                        | Fee Description                       |                  |          |
|  | \$50                                | \$25                                    | Claims in excess of 20                |                  |          |
|  | \$200                               | \$100                                   | Independent claims in excess of 3     |                  |          |
|  | \$380                               | \$180                                   | Multiple dependent claim, if not paid |                  |          |
| <b>3. Fee for Petition for Extension of Time</b>         |                                     |   |                                       |                  |          |
| Large Entity Fee   | Small Entity Fee                    |   |                                       |                  |          |
| \$120  | \$60                                | Extension for reply within first Month  |                                       |                  | 0        |
| \$450  | \$225                               | Extension for reply within second Month |                                       |                  | 0        |
| \$1,020  | \$510                               | Extension for reply within third Month  |                                       |                  | 0        |
| \$1,590  | \$795                               | Extension for reply within fourth Month |                                       |                  | 0        |
| <b>4. Surcharge Fee Under 37 CFR 1.16(f) or 1.492(h)</b> |                                     |   |                                       |                  |          |
|  | Large Entity Fee                    | Small Entity Fee                        |                                       |                  |          |
| Utility  | \$130                               | \$65                                    | 0                                     |                  |          |
| <b>5. Surcharge Fee Under 37 CFR 1.16(i)</b>             |                                     |   |                                       |                  |          |
|  | Large Entity Fee                    | Small Entity Fee                        |                                       |                  |          |
| Provisional  | \$50                                | \$25                                    | 0                                     |                  |          |
| <b>TOTAL (all columns)</b>                               |                                     |   |                                       |                  | <b>0</b> |

As discussed, no fees are believed to be due. However, if any additional fee is required, the undersigned hereby authorizes the Patent Office to charge such additional fee to Deposit Account 50-3355.

Respectfully submitted,

/Caleb Pollack/

Caleb Pollack, Reg. No. 37,912  
 Attorney/Agent for Applicant(s)

Dated: February 14, 2007

Pearl Cohen Zedek Latzer LLP.  
 1500 Broadway, 12th Floor  
 New York, New York 10036  
 Tel: (646) 878-0800  
 Fax: (646) 878-0801



## UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

PEARL COHEN ZEDEK, LLP  
1500 BROADWAY 12<sup>TH</sup> FLOOR  
NEW YORK, NY 10036

**17 AUG 2006**

In re Application of  
ADLER, Sam et al  
Int. Application: PCT/IL03/01117  
Application No.: 10/541,191  
Int. Filing Date: 30 December 2003  
Priority Date: 30 December 2002  
Attorney's Docket No.: P-5608-US  
For: UNIVERSAL RETICLE TRANSFER SYSTEM

DECISION ON

REQUEST UNDER

37 CFR 1.497(d)

This is a decision on petitioner's "PETITION TO ADD AN INVENTORS 37 CFR 1.324" filed on 14 June 2006, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Daniel Gat in the executed declaration. A petition fee of \$130.00 has been charged to petitioner's Deposit Account No. 50-3355 as authorized in the petition.

**BACKGROUND**

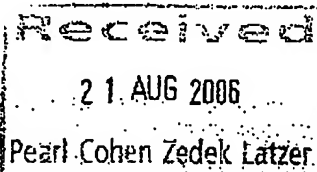
On 30 December 2003, applicants filed international application No. PCT/IL2003/01117 and claiming a priority date of 30 December 2002.

On 30 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee, but no executed declaration was submitted at such time.

On 22 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notice also indicated that the items set forth above must be submitted within two (2) months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 18 April 2006, applicants filed, inter alia, an executed declaration but it did not include joint inventor Daniel Gat in the executed declaration.

On 14 June 2006, applicants filed, inter alia, a request under 37 CFR 1.497(d) to add joint inventor Daniel Gat in the executed declaration.



Application No.: 10/541,191

2

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied item (2) under 37 CFR 1.497(d), but not items (1) and (3).

With respect to item (1), the statement submitted on 14 June 2006 by Daniel Gat is sufficient because the statements state that the error in inventorship occurred without a deceptive intent in the national stage application. However, the executed declaration filed on 18 April 2006 is defective because it does not list alleged co-inventor Daniel Gat, which makes the statements moot as there is no support for his co-inventorship in the declaration.

With respect to item (2), the processing fee of \$130.00 has been charged to the Deposit Account No.: 50-3355.

With respect to item (3), Given Imaging, Ltd., the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b), since the assignment has been recorded in USPTO at Reel/Frame 017494/0862. However, this statement is moot because no executed declaration including alleged co-inventor Daniel Gat has been submitted.

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Application No.: 10/541,191

3

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

---

  
Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459

FEB 15 2007

Page 1 of 2



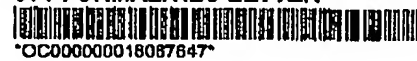
## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|-----------------------------|-----------------------|------------------|
| 10/541,191                  | Sam Adler             | P-5608-US        |

49443  
PEARL COHEN ZEDEK, LLP  
1500 BROADWAY 12TH FLOOR  
NEW YORK, NY 10036

| INTERNATIONAL APPLICATION NO. |               |
|-------------------------------|---------------|
| PCT/IL03/01117                |               |
| I.A. FILING DATE              | PRIORITY DATE |
| 12/30/2003                    | 12/30/2002    |

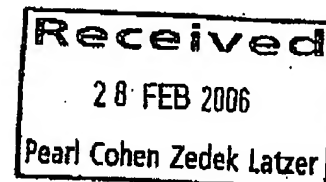
CONFIRMATION NO. 6216  
371 FORMALITIES LETTER

Date Mailed: 02/22/2006

## NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 06/30/2005
- Copy of the International Search Report filed on 06/30/2005
- Preliminary Amendments filed on 06/30/2005
- Information Disclosure Statements filed on 06/30/2005
- Oath or Declaration filed on 06/30/2005
- Request for Immediate Examination filed on 06/30/2005
- U.S. Basic National Fees filed on 06/30/2005
- Priority Documents filed on 06/30/2005
- Power of Attorney filed on 06/30/2005
- Specification filed on 06/30/2005
- Claims filed on 06/30/2005
- Abstracts filed on 06/30/2005
- Drawings filed on 06/30/2005



The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and International filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - Is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath

BEST AVAILABLE COPY

or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Surcharge.

RECEIVED  
CENTRAL FAX CENTER

FEB 15 2007

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice MUST be returned with the response.*

BARBARA A CAMPBELL

Telephone: (703) 308-9140 EXT 217

**PART 1 - ATTORNEY/APPLICANT COPY**

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/541,191                  | PCT/IL03/01117                | P-5608-US        |

FORM PCT/DO/EO/905 (371 Formalities Notice)

**IAP13 Rec'd PCT/PTO 15 FEB 2007**  
**RECEIVED**  
**CENTRAL FAX CENTER**

**FEB 15 2007**

**COVER PAGE LISTING DOCUMENTS BEING TRANSMITTED VIA FACSIMILE**

**30** Pages Via Facsimile: 571-273-8300  
 Commissioner for Patents  
 P. O. Box 1450  
 Alexandria, VA 22313-1450

**Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (fax no. 571-273-8300) on February 15, 2007.

  
 Laura Saporta

Regarding the following Application:

Applicant(S): ADLER, Sam et al.

Examiner: Not Yet Assigned

Serial No./ Patent No.: 10/541,191

Group Art Unit: Not Yet Assigned

Filed/Issued Date: June 30, 2005

Attorney Docket No.: P-5608-US

Title: METHOD FOR IN VIVO SENSING

**Please find:**

- |  |  |
|--|--|
| <p>1. <input type="checkbox"/> Provisional Cover Sheet</p> <p>2. <input type="checkbox"/> Utility Patent Application Transmittal</p> <p>3. <input type="checkbox"/> RCE Transmittal Sheet</p> <p>4. <input type="checkbox"/> Fee Transmittal Sheet</p> <p>5. <input type="checkbox"/> Patent Application Under 35 USC 111(a)</p> <p style="padding-left: 20px;"><input type="checkbox"/> Provisional Patent Application Under 35 USC 111(b)</p> <p style="padding-left: 20px;"><input type="checkbox"/> Transmittal Sheet for Entering National Phase</p> <p style="padding-left: 40px;">Containing:</p> <p style="padding-left: 60px;">____ Pages of Specification</p> <p style="padding-left: 60px;">____ Pages of Claims</p> <p style="padding-left: 60px;">____ Page of Abstract</p> <p style="padding-left: 60px;">____ Pages of Formal Drawings</p> <p style="padding-left: 60px;">____ Pages of _____</p> <p>6. <input checked="" type="checkbox"/> Signed Declaration &amp; Power of Attorney</p> <p>7. <input type="checkbox"/> Request for Correction of Recordation of Assign. and:</p> <p style="padding-left: 20px;">- Recordation Cover Sheet</p> <p style="padding-left: 20px;">- Copy of Notice of Recordation of Assign.</p> <p>8. <input type="checkbox"/> Recordation of Assign. Cover Sheet &amp; Signed Assign.</p> | <p>9. <input checked="" type="checkbox"/> Response to Notice to File Missing Parts</p> <p>10. <input checked="" type="checkbox"/> Response to Decision on Request</p> <p>11. <input type="checkbox"/> Request for Correction of Filing Receipt</p> <p>12. <input type="checkbox"/> Information Disclosure Statement including:</p> <p style="padding-left: 20px;">- Form PTO/SB/08 and references _____</p> <p>13. <input type="checkbox"/> Preliminary Amendment</p> <p>14. <input type="checkbox"/> Response to Office Action dated _____</p> <p>15. <input type="checkbox"/> Petition for a One Month(s) Extension of Time</p> <p>16. <input type="checkbox"/> Notice of Appeal <input type="checkbox"/> Appeal Brief _____</p> <p>17. <input type="checkbox"/> Issue Fee Transmittal <input type="checkbox"/> Publication Fee</p> <p>18. <input type="checkbox"/> Submission of Formal Drawings: Two sets of _____ Sheets containing Figs. _____</p> <p>19. <input type="checkbox"/> Copy of Priority Doc.</p> <p>20. <input type="checkbox"/> Claim for Convention Priority</p> <p>21. <input type="checkbox"/> Revocation and Power of Attorney, including:</p> <p style="padding-left: 20px;">- Statement Under 37 CFR 3.73(b)</p> <p style="padding-left: 20px;">- Copy of Assignment</p> <p>22. <input checked="" type="checkbox"/> Other: <u>Copy of Decision on Request</u><br/> <u>Copy of Notice of Missing Parts</u><br/> <u>Copy of Assignment documents</u><br/> <u>Statements of facts of co-inventor (3 sheets)</u><br/> <u>Written consent of Assignee</u><br/> <u>Statement under 37 CFR</u></p> |
|--|--|

**BEST AVAILABLE COPY**



RECEIVED  
CENTRAL FAX CENTER

FEB 15 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): ADLER, Sam et al. EXAMINER: Not Yet Assigned  
SERIAL NO.: 10/541,191 GROUP ART UNIT: Not Yet Assigned  
FILED: June 30, 2005 ATTORNEY DOCKET No.: P-5608-US  
FOR: METHOD FOR IN VIVO SENSING

Mail Stop Missing Parts  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO DECISION ON REQUEST UNDER 37 CFR 1.497(D)**

Sir:

In response to the Decision on Request Under 37 CFR 1.497(d) mailed August 17, 2006, Applicants are attaching:

- 1) A Declaration;
- 2) Statements of Facts of the inventors (three statements)
- 3) Consent of Assignee
- 4) Statement under 37 CFR 3.73(b)
- 5) A Response to Notice of Missing Parts;
- 6) The Decision; and
- 7) The Notice.

A Notification of Abandonment was mailed in connection with the above captioned application. This Notification of Abandonment was mailed in error, as the August 17, 2006 Decision set a term for reply that is extendible to six months. In a conversation on January 18, 2007 between the undersigned and Examiner Barbara Campbell, the Examiner who signed the Notification of Abandonment, Examiner Campbell agreed that the notice of abandonment was issued in error.

A response to the Decision was due October 17, 2007. Applicants hereby petition to extend the period of response by four (4) months, to February 17, 2007. The fee for the petition for extension of time is being paid below. Accordingly, this response is being timely filed.

The Decision notes that the \$130.00 fee under 37 CFR 1.17(i) has been paid.

The undersigned authorizes the Office to charge the fee of \$1,590 for a petition for four month's extension of time to Deposit Account 50-3355.

02/20/2007 GFREY1 00000026 503355 10541191

01 FC:1254 1590.00 DA

PAGE 2/30 \* RCVD AT 2/15/2007 8:09:58 AM [Eastern Standard Time] \* SVR:USPTO-EFXXF-5/22 \* DNIS:2738300 \* CSID:6464175511 \* DURATION (mm-ss):08-40

BEST AVAILABLE COPY

If any additional fee is required, the undersigned hereby authorizes the Patent Office to charge such additional fee to Deposit Account 50-3355.

Respectfully submitted,

/Caleb Pollack/

Caleb Pollack, Reg. No. 37,912

Attorney/Agent for Applicant(s)

Dated: February 19, 2007

**Pearl Cohen Zedek Latzer LLP.**  
1500 Broadway, 12th Floor  
New York, New York 10036  
Tel: (646) 878-0800  
Fax: (646) 878-0801